

REMARKS

I. Status of Claims

Claims 1-4, 8-20, 22, 25-51, and 57-63 are currently pending. The claims are not amended herein.

II. Rejections Under 35 U.S.C. § 103(a)

The Office rejects claims 1-4¹, 8-20, 22, 22-51, and 57-63, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,403,704 (“the ‘704 patent”), U.S. Patent No. 6,689,345 (“the ‘345 patent”) or U.S. Patent No. 6,565,862 (“the ‘862 patent”), in view of U.S. Patent No. 4,710,375 (“the 375 patent”) or U.S. Patent No. 5,486,354 (“the ‘354 patent”). Office Action at 6-10. The Office also rejects claims 1-4², 8-20, 22, 25-51 and 57-63 as being obvious over EP 1064930 (“EP 930”) in view of the ‘375 patent or the ‘354 patent or JP 2000103717 (“JP 717”) in view of EP 930 and one of the ‘375 patent or the ‘354 patent. *Id.* at 10-14.

In the Office Action, the Office concedes that the ‘704, ‘345, ‘862 patents and EP 930 and JP 717 fail to teach the claimed ratios. *Id.* at 7, 8, 9. The Office also concedes that JP 717 “fails to teach the claimed particulate phase B” and “pearlescent materials.” *Id.* at 11. The Office alleges that it “would have been obvious” for a skilled artisan “to optimize the amounts” of the components in the composition. *Id.* at 8, 9, 11.

Further, the Office newly cites the ‘375 patent and the ‘354 patent. *Id.* at 6-10. The ‘375 patent, according to the Office, “suggests the amount of pigment as high as

¹ Applicants note that the Office Action refers to claim 5 in the rejection, however this claim was previously cancelled and is not currently pending.

² Applicants note that claims 21, 23, and 24 were previously cancelled and are not currently pending.

20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties . . .” *Id.* at 9. With respect to the ‘354 patent, the Office states the reference “also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1),” and that the “pigment” is taught in an amount of “0.5 to 30% f (sic) the total composition (see claim 1 of the patent).” *Id.* at 12.

With respect to the amounts of the components recited in the claims, the Office states that it “would have been obvious” for a skilled artisan “to optimize the amounts” of the components in the composition. *Id.* at 8, 9, 11. In the Office Action dated March 18, 2009, incorporated in the present rejection, in response to Applicants arguments, the Examiner contends it “would have been able to optimize the amounts of the components . . . to obtain a desired texture of the final composition” and “would have readily recognized that a paste composition requires more of water containing phase than a powdery composition.” See Office Action at 14, and Office Action dated March 18, 2009 at 11, 13-14, 18. Applicants respectfully traverse the rejection and submit that the Examiner fails to establish a prima facie case of obviousness for reasons of record and the following reasons.

Independent claims 1, 59, 62, and 63 recite several ratios and amounts that the Examiner concedes are not taught by the cited references. Specifically, the ‘704 patent “do[es] not teach the claimed ratios of the particulate phase and binder” (Office Action at 7); ‘862 “fail to teach the claimed ratios or percentages of the components A, B, and C” (*id.*); ‘345 “fail to teach the claimed ratios or percentages of the components A, B and C”; and further “US ‘345 and ‘704 does (sic) not specifically teach pearlescent pigments their amounts” (*id.* at 9). The Examiner further concedes that with respect to the ‘862

patent, which according to the Office overlaps the claimed range, “one cannot immediately envisage the cosmetic compositions with claimed amounts of pearlescent agents from the composition.” *Id.* The Examiner attempts to rectify some of these deficiencies, specifically, the deficiencies with regards to the amount of pearlescent agents, with the ‘345 and ‘375 patents. Applicants submit that a person of skill in the art viewing these disclosures, alone or in combination, would not arrive at the presently claimed invention.

It is important to note that a *prima facie* case of obviousness requires a reasonable expectation of success. M.P.E.P. 2143.02; *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. MPEP 2143.02; *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Because of the demonstrated unpredictability in this case, a person of ordinary skill in the art would not be able to arrive at the compositions of the present claims with any reasonable expectation of success.

Applicants respectfully submit that the Declaration under 37 C.F.R. § 1.132 of Marie-Laure DELACOUR (“the Delacour Declaration”) previously submitted on December 8, 2008, and the Declaration of Jean-Louis MATTEI (“the Mattei Declaration”), submitted herewith, highlight the unpredictability in the art. As Applicants have previously asserted, the Delacour Declaration demonstrates that inventive Compositions 1 and 4 “exhibit a pulverulent-to-pasty texture and are sufficiently elastic and deformable such that their shapes can be easily modified, for example, manually, without exudation,” and “are sufficiently solid and cohesive such that they can retain the cylindrical shape obtained upon extrusion and can be left in the cylindrical shape at

ambient temperature and pressure without changing shape, for at least three hours” (pages 4-5 of the Delacour Declaration). In contrast, comparative compositions 2 and 3 are “fragile, crumbly powders, which are unable to maintain the cylindrical shape obtained upon extrusion for any length of time” (page 5 of the Delacour Declaration).

The inaccuracy of the Examiner’s statement that a skilled artisan “would have been able to optimize the amounts of the components . . . to obtain a desired texture of the final composition” and “would have readily recognized that a paste composition requires more of water containing phase than a powdery composition” is clearly highlighted by the results in the Mattei Declaration. See Office Action dated March 18, 2009 at 11, 13-14, 18. The Mattei Declaration shows that comparative compositions containing identical amounts of water, in contrast to the Examiner’s statement, have a different texture depending on the amount of pearlescent agent in the composition. For example, comparative composition 1, comparative composition 2, and inventive composition 2 all contain 28% water. Yet, an amount of pearlescent agent outside the claimed range, as in comparative composition 1 or 2, results in a fragile, crumbly cylinder (page 2 of the Mattei Declaration). In contrast, using pearlescent agent instead of talc, with an identical amount of water, results in a pasty cylinder as shown in inventive composition 2 (page 2 of the Mattei Declaration). Similarly, inventive composition 3 and comparative composition 3 contain 18.5% of water, yet have different textures (page 2 of the Mattei Declaration).

Thus, the Examiner’s statement that a skilled artisan would arrive at the presently claimed texture simply because “a paste composition requires more of water containing phase than a powdery composition,” is incorrect. See Office Action dated March 18, 2009 at 11, 13-14, 18. As the Examiner has acknowledged, the ‘704, ‘862, and ‘345

patents do not teach the claimed ratios of organopolysiloxane to particulate phase and binder. The Examiner does not contend that the '375 or '354 patent rectify this deficiency. However, the Examiner argued that one of ordinary skill in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents to achieve the claimed invention.

As Applicants have pointed out, those patents do not suggest or provide any guidance regarding the desirability of the claimed ratios. Instead, they teach the amounts of the organopolysiloxane and particulate phases in terms of widely varied percentage. This deficiency is not rectified by the '375 or the '354 patent. Accordingly, as the Meralli declaration further demonstrates the unpredictability in the art, there is no *prima facie* case of obviousness and Applicants respectfully request that the rejection be withdrawn.

Moreover, regarding pearlescent agents, as Applicants have previously submitted, the '862 and '345 patents do not use any pearlescent agents in their examples, and the '704 patent only describes the use of 5% brown nacre (Example 3 at column 9). Notably, all of these amounts are outside the presently claimed range from 10% to 50%. Thus, the general guidance in each of the three patents provides no reason for a person of ordinary skill to use a larger amount of pearlescent agents in an attempt to arrive at the claimed invention. And the specific guidance provided by the teachings of the examples in these patents leads the person away from the claimed invention.

With respect to the '375 patent, Applicants respectfully submit that the reference as a whole does not teach that high amounts of pearlescent agents can impart the presently claimed texture. The '375 patent requires a particular ratio of pigment to

metallic coating, wherein ratios above and below are stated to demonstrate poor results. '375 patent at col. 4, ll. 17-29. Moreover, the '375 patent additionally requires as an "important point" of the invention, that "the pigment coated with metallic soap contains water by 20 wt. % or more." *Id.* at col. 4, ll. 30-32. In contrast, the present claims do not require a pearlescent agent containing water. For example, in the Delacour Declaration and in the Mattei Declaration, the pearlescent agent in the particulate phase contains no water, while water is present only in the binder. Thus, a person of skill in the art viewing the '375 patent would not be motivated to modify the teachings of the '375 patent, much less to combine pearlescent pigments with the teachings of the '375 patent to arrive at the present claims given the unpredictability in the art.

Nor would a skilled artisan arrive at the presently claimed invention viewing the disclosure of the '354 patent. The Examiner's statement that "the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application" disregards the technical teachings of the '354 patent. See Office Action at 10. Specifically, the '354 patent teaches using "a transparent pigment." See, e.g., '354 patent at col. 1, ll. 44, 53, 63. With respect to other pearlescent pigments, the '354 patent states that "when it is desired to enhance the pearlescent effect, it is possible to increase the amount of mother-of-pearl but in this case, problems of cohesion are encountered which necessitate increasing the amount of binder such that it causes inconvenience during application." *Id.* col. 1, ll. 24-28. Thus, the '354 patent would lead a person of skill in the art away from using non-transparent pearlescent agents. See col. 1, ll. 41-50. Applicants respectfully submit that the '354 patent contains no teaching of using pearlescent agents generally in high amounts, and a

person of skill in the art would not combine this reference with the '704, '862, and '345 patents in the manner suggested by the Examiner given the unpredictability in the art.

Because of the significant unpredictability in the properties of the compositions having components in different amounts, one of ordinary skill would not have a reasonable expectation of success in using a larger amount of pearlescent agent in the composition to achieve desired properties and arrive at the claimed invention. The Declarations provide objective evidence supporting this conclusion. Therefore, no prima facie case has been made.

Finally, in response to the Examiner's statement that the results in the Delacour Declaration "are not of the same scope of the instant claims," Applicants again submit that these results demonstrate the unpredictability of the modifications suggested by the Examiner. As such, these results showing unpredictability undermine the foundation of the Examiner's rejection – that it would be obvious to optimize the amounts of the components – and Applicants respectfully request the withdrawal of the rejection over the '704, '862, and '345 patents in view of the '375 or '354 patents.

EP '930 and JP '717 in view of '375 or '354

The Examiner relies on the disclosure of the '345 patent as a translation of EP '930 in this rejection. Office Action at 11. As discussed above, no prima facie case of obviousness has been made with respect to the '345 patent in view of the '375 or '354 patents. Accordingly, Applicants respectfully request that the rejection over EP '930 in view of the '375 or '354 patents be withdrawn.

The Examiner asserts that JP '717 teaches a solid cosmetic composition comprising from 0.1 to 50% by weight of organopolysiloxane. See Office Action at 11. The Examiner admits that JP '717 "fails to teach the claimed particulate phase B in the

composition and the additional components . . . of the instant claims” and relies on EP ‘930, the ‘375 patent, and the ‘345 patent to remedy the deficiencies of JP ‘717. *Id.* at 11-12. The Examiner argues that it would have been obvious to include the cosmetic additives of EP ‘930 in the composition of JP ‘717 and incorporate pearlescent pigments of ‘375 or ‘354 in amount of 20-95% or 0.5-30% “depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition.” *Id.* at 12. The Examiner further contends that “US ‘354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application.” *Id.* The Examiner alleges that all the references are directed to the same type of cosmetic compositions. See *id.* at 13.

Applicants submit that JP ‘717 is completely silent with respect to the use of pearlescent agents, let alone teaching an amount ranging from 10% to 50% by weight, relative to the total weight of the composition. Further, it fails to provide any guidance with respect to the desirability of using pearlescent agents in an amount in the claimed range, and fails to provide a reasonable expectation of success in arriving at the claimed invention.

As discussed above, EP ‘930 (the ‘345 patent), the ‘375 patent and the ‘354 patent fail to provide a reasonable expectation of success for a person of ordinary skill to arrive at the presently claimed invention . Moreover, EP 930 (the ‘345 patent) in combination with the ‘375 or ‘354 patents fails to rectify the deficiency of JP ‘717 as it does not teach or suggest the claimed range or pearlescent agents beyond the specific types of the pearlescent agents in the ‘375 and ‘354 patents, and fails to provide a

reason for a person of ordinary skill in the art to go beyond its disclosure to arrive at the claimed invention. Therefore, JP '717 in view of EP 930 and in view of the '375 or '354 patents does not establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection over JP '717 in view of EP 930 and in view of the '375 or '354 patent be withdrawn.

III. Obviousness-Type Double Patenting Rejection

Claims 1-4, 8-20, 22, 25-51 and 57-63 remain rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-63 of the '345 patent in view of US 4,710,375 or in view of US 5,486,354. See Office Action at 2.

The Examiner concedes that the '345 patent does not teach the exact ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the '345 patent to achieve the present invention. See *id.* at 3-4. The Examiner also contends that it would have been obvious, based on the teachings of the '375 or '354 patents, to incorporate pearlescent pigments in the claimed amounts in a composition to arrive at the present claims. See *id.* at 5. Applicants respectfully traverse the rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '345 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a

claim in the application is an obvious variation of the invention defined in a claim” in the ‘345 patent. See MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that pending claims 1-4, 8-20, 22, 25-51, and 57-63 of this application are not obvious over claims 1-63 of the ‘345 patent in view of the ‘375 or ‘354 patents.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently claimed invention is an obvious variation of the invention claimed in the ‘345 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the ‘345 patent in view of the ‘375 or ‘354 patents teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1.

Independent claims 1, 59, 62, and 63, recite “wherein said at least one particulate phase B comprises at least one pearlescent agent, present in an amount ranging from 10% to 50% by weight, relative to the total weight of the composition.” As discussed above in the section regarding the 35 U.S.C. § 103 rejections, the Office has failed to show that the presently claimed invention is an obvious variation of the invention claimed in the ‘345 patent alone or in view of the ‘375 and ‘354 patents. Because of the unpredictability in the art, a person of skill in the art would not modify and combine the cited references with any reasonable expectation of success. Therefore, the Office has failed to satisfy those requirements in this rejection.

Accordingly, this rejection is improper and Applicants respectfully request that the rejection be withdrawn.

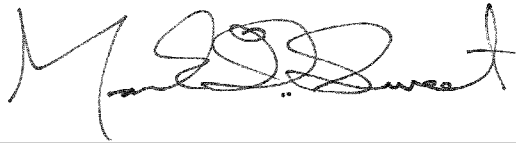
IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to read 'Mark D. Sweet', written over a horizontal line.

Dated: March 29, 2010

By: _____

Mark D. Sweet
Reg. No. 41,469